

THIS DISPOSITION  
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PRECEDENT OF  
THE TTAB

Oral Hearing:  
March 4, 2003

Mailed: July 30, 2003  
Paper No. 25  
CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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In re Spanky's Inc.  
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Serial No. 75/492,749  
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Penrose Lucas Albright of Mason, Mason & Albright for  
Spanky's Inc.

Nicholas K.D. Altree, Trademark Examining Attorney, Law  
Office 109 (Ronald R. Sussman, Managing Attorney).  
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Before Seeherman, Walters and Holtzman, Administrative  
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Spanky's Inc. has filed an application to register  
on the Principal Register the mark SPANKY'S for  
"clothing, namely, t-shirts, sweat pants, sweat shirts,

shirts, jackets, headwear, undergarments, gloves and scarves."<sup>1</sup>

The Trademark Examining Attorney has issued a final refusal to register, under Section 2(a) of the Trademark Act, 15 U.S.C. 1052(a), on the ground that applicant's mark creates a false suggestion of a connection with George "Spanky" McFarland, who played the character "Spanky" on "The Little Rascals" series.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs and an oral hearing was held. We reverse the refusal to register.

The Examining Attorney contends that applicant's mark, SPANKY'S, is the nickname and identity of George McFarland, who, as a child, played the role of Spanky in the "Our Gang," also known as "Little Rascals," comedies that have appeared in movie theaters and on television; that Mr. McFarland's nickname and character name, Spanky, and his likeness as a child are famous in the United States in connection with the "Our Gang" comedies; that applicant uses the mark SPANKY'S in connection with Mr.

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<sup>1</sup> Serial No. 75/492,749, in International Class 25, filed May 29, 1998, based on use of the mark in commerce, alleging first use and use in commerce as of September 12, 1974. The application includes the statement "Applicant is the owner of Trademark Registration No. 1,238,845 of May 17, 1983." The claimed registration is a concurrent use registration for the mark SPANKY'S for "delicatessen restaurant business."

McFarland's childhood likeness on applicant's identified clothing items and in connection with applicant's restaurant services; that applicant's restaurant has an "Our Gang" comedies theme; and, thus, that Mr. McFarland is clearly identified by applicant's mark SPANKY'S.

The Examining Attorney contends, further, that Mr. McFarland is not associated with the goods sold under applicant's mark; and that Mr. McFarland, as the "Our Gang" character, Spanky, is sufficiently famous that a connection will be presumed between Mr. McFarland and the mark SPANKY'S as used on applicant's identified clothing.

In support of his position, the Examining Attorney submitted excerpts from various Internet websites. Some of the websites discuss, or contain biographies of, celebrities, including George McFarland as Spanky in the "Our Gang" comedies, while others sell "Our Gang" branded products.

Applicant admits, essentially, that its restaurant has an "our Gang" comedies theme and that the picture shown with the mark SPANKY'S on the specimens submitted with its application is the likeness of George McFarland in his role as Spanky in the "Our Gang" comedies (applicant's April 17, 2001 response, pp. 2-3).

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Applicant submitted the declaration of Roland Harry Macher, applicant's president, who stated that applicant entered into an agreement with King World Productions, in approximately 1975, permitting "applicant's restaurant to operate under the name SPANKY'S, to use the name 'Our Gang' and to utilize the names of 'Our Gang' actors as well as their pictures in its restaurant business ... [and allowing applicant] to sell articles and clothing having thereon various logos, caricatures and slogans, all referencing SPANKY'S or 'Our Gang'" (applicant's brief p. 5); and that applicant no longer has a copy of this agreement, but applicant paid \$500 in royalties for these rights.<sup>2</sup>

Mr. Macher stated, further, that in 1986 applicant received what was essentially a cease and desist letter from George McFarland's attorney that alternatively sought compensation for applicant's use of SPANKY'S and the childhood likeness of Mr. McFarland; that applicant's then-president had a telephone conversation with Mr. McFarland's attorney; that no compensation was paid to

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<sup>2</sup> Without evidence in support of his position, the Examining Attorney challenges the existence of such an agreement. We find no basis for questioning Mr. Macher's statement that such an agreement existed and the stated provisions thereof. We note, however, that the term of the agreement has not been specified in this record, although applicant appears to indicate that the agreement existed only for "several" years (applicant's April 14, 2001 response, p. 3).

Mr. McFarland nor were any changes made to applicant's business; and that applicant did not hear from Mr. McFarland or his attorney again.

Applicant concludes, therefore, that applicant's use of its mark is permitted, or at least not objected to, by those who may have the right to license the "Our Gang" names and characters.

In *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), the Court of Appeals for the Federal Circuit stated that to succeed on a Section 2(a) false suggestion of a connection ground, the plaintiff (in this case, the Examining Attorney) must demonstrate that the name or equivalent thereof claimed to be appropriated by another (in this case, applicant) must be unmistakably associated with a particular personality or "persona" and must point uniquely to the plaintiff. The Board, in *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985), in accordance with the principles set forth in *Notre Dame*, required that a plaintiff asserting a claim of a false suggestion of a connection demonstrate 1) that the defendant's mark is the same or a close approximation of plaintiff's previously used name or identity; 2) that the mark would be recognized as such; 3) that the plaintiff is not

connected with the activities performed by the defendant under the mark; and 4) that the plaintiff's name or identity is of sufficient fame or reputation that when the defendant's mark is used on its goods or services, a connection with the plaintiff would be presumed.<sup>3</sup>

The Examining Attorney has submitted evidence establishing that the "Our Gang" comedies and the character, Spanky, appearing in those comedies is likely to be well known to the general public. This conclusion is supported by applicant's admission that it uses the name and likeness of George McFarland as the child actor, Spanky, in its restaurant and that its restaurant has an "Our Gang" comedies theme. The channels of trade for applicant's identified clothing items are not limited and one normal trade channel for applicant's clothing is sales at or in connection with applicant's restaurant.

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<sup>3</sup> In its brief, applicant argues that the Examining Attorney's position rests principally on the right of either publicity or privacy; that such rights exist under the Trademark Act only in Section 43(a), not Section 2(a); and that, therefore, the refusal under Section 2(a) is improper. While the Section 2(a) refusal for a false suggestion of a connection may be derived from the rights of privacy or publicity, it is clear that "false suggestion of a connection" is an appropriate ground for refusal in the ex parte context, and is determined according to the standards set forth in this opinion.

Further, in support of their respective positions, both applicant and the Examining Attorney refer to various court proceedings in different jurisdictions involving Mr. McFarland. The referenced cases resulted in different outcomes, pertained primarily to Mr. McFarland's alleged rights of publicity and privacy, and were based on state and common law and Section 43(a) of the Trademark Act. As such, we find these cases are of little if any relevance to this ex parte appeal.

At least in this context, we can conclude that the name, Spanky, as used in connection with applicant's identified clothing, is likely to be perceived as the name of the character in the "Our Gang" comedies.

However, the Examining Attorney has not met the other elements necessary to establish the Section 2(a) claim. Furthermore, based on the facts presented by the Examining Attorney and applicant, it would be difficult to establish these elements in this ex parte context. In particular, the record raises more questions than it answers about who or what entity owns the rights associated with the "Our Gang" comedies and the characters appearing in those comedies; and whether applicant had or continues to have a valid license to use any trademark associated with the "Our Gang" comedies. In other words, the Examining Attorney has not established that the party owning rights in "Spanky" is not connected with applicant's activities under the mark.

*Decision:* The refusal under Section 2(a) of the Act is reversed.